

## **REMARKS**

### **The Amendments**

Claim 1 is amended to remove certain embodiments to further distinguish the cited prior art, as discussed below.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

### **The Rejection under 35 U.S.C. §103**

The rejection under 35 U.S.C. §103 of claims 1, 2, 5-8, 10, 20, 21 and 23-27 over Pfaff (U.S. Patent No. 6,517,628) in combination with Motitschke (U.S. Patent No. 6,060,071) is respectfully traversed.

Applicants submit that the references do not teach or fairly suggest the feature of the claimed invention that the component A pigment is based on a thin glass flake with a layer thickness of  $\leq 1 \mu\text{m}$ . Although Pfaff has general teachings for its pigment base, there is no particular direction to such specific thin glass flakes.

It is further believed that the above amendments to claim 1 provide a further basis for distinguishing the cited prior art. Pfaff also does not teach or fairly suggest the feature of the claimed invention wherein the pigment has one of the specific layer arrangements as recited in the instant claims.

Particularly, applicants urge that the combined teachings of Pfaff and Motitschke fail to

provide a fair suggestion of picking and choosing specific features to arrive at the specific combination of the claimed invention.

Pfaff discloses pigment mixtures having a component A which is a multilayer pigment based on a substrate with multiple oxide layers. Pfaff lists a number of possible substrate substances including mica, SiO<sub>2</sub> flakes, glass flakes, Al<sub>2</sub>O<sub>3</sub> flakes and polymer flakes; see, e.g., col. 1, lines 38-45. Pfaff discloses that the substrate materials may have a thickness of 0.3 to 5 µm; see, e.g., col. 2, lines 1-5. While Pfaff, thus, generically encompasses the possibility of its component A being a pigment based on glass flakes having a layer thickness of ≤ 1 µm, it would require a very specific selection within the broad Pfaff disclosure to arrive at such an embodiment. Further, there are no other teachings in Pfaff which would direct one of ordinary skill in the art to make such a specific selection. Pfaff provides no disclosure specific to selecting glass flakes from among the generic possibilities as the substrate for its pigment. To the contrary, in all of the examples of Pfaff, the substrate for component A is either mica or SiO<sub>2</sub>. Further, Pfaff provides no specific descriptions regarding the thickness of the substrates of its pigments used in the examples or otherwise. Thus, Pfaff attributes no particular significance to the thickness of the substrate or any preference to glass flakes having a layer thickness of ≤ 1 µm. Contrast the disclosure of such preferences in the instant specification at page 4, paragraphs [0013] and [0015].

Regarding the oxide layers on the substrate, Pfaff provides a generic disclosure of having multiple oxide layers on the substrate; see, e.g., col. 2, lines 8-26. Thus, while Pfaff generically encompasses the combination of oxide layers recited for component A of the instant claims, it would require a another very specific selection within the broad Pfaff disclosure to arrive at an

embodiment according to the instant claims. Pfaff provides no disclosure specific to selecting a combination of oxide layers as particularly recited for the instant claims for its pigment. To the contrary, Pfaff's disclosure at col. 2, lines 30-35, and in its examples points to combinations of oxides distinct from those recited for the instant claims.

In view of the above discussion of the two types of particular selections one would have to make from the broad generic disclosure of Pfaff, applicants respectfully urge that Pfaff fails to fairly suggest an embodiment according to the instant claims which would require both making each of these particular types of selections and also specifically combining the results from such specific selections. There is no fair direction from Pfaff to make such specific selections and combination. To the contrary, Pfaff directs one of ordinary skill in the art to other embodiments distinct from the instant claims. As was clearly set forth in In re Jones, 21 USPQ 2d 1941 (Fed. Cir. 1992), it is not the law that "... regardless of how broad, a disclosure of a chemical genus renders obvious any species which happens to fall within it." Instead, the disclosure must be considered as a whole as to whether it fairly suggests the claimed invention to one of ordinary skill in the art. See also In re Baird, 29 USPQ2d 1550 (Fed. Cir. 1994). It is urged that the instant facts are analogous to those in Jones and Baird and there is no fair suggestion of the claimed invention from Pfaff's generic disclosure.

The Motitschke reference was cited only for its teaching regarding ectoin as a cosmetic component. For the above reasons, applicants urge that Pfaff fails to suggest the specific component A pigment of the claimed invention. Motitschke fails to make up for this deficiency in Pfaff and was not cited for that reason. Thus, combination of ectoin into the Pfaff compositions would still not result in or suggest the claimed invention to one of ordinary skill in

the art.

Accordingly, it is urged that the combination of Pfaff and Motitschke, considered as a whole, fails to render the claimed invention obvious to one of ordinary skill in the art. Thus, the rejection under 35 U.S.C. §103 should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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